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| 09/944,102 | 09/04/2001 | Luis Antonio Ruiz | 32935RC497723 | 2486 |

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EXAMINER

SHAY, DAVID M

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| ART UNIT | PAPER NUMBER |
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3739

DATE MAILED: 04/18/2003

5

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/944102

Applicant(s)

Ruij

Examiner

J. Shaw

Group Art Unit

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—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE —3— MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on July 29, 2002
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed in** accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-31 is/are pending in the application.
Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-31 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____
 - ☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____ ☐ Interview Summary, PTO-413
- ☒ Notice of Reference(s) Cited, PTO-892 ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948 ☐ Other _____

Office Action Summary

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 3, 4, 8, 9, and 12 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no description of the lighting conditions under which the pupil diameter is to be measured and with respect to claim 12 "dioptr" is not defined.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3, 4, 8, 9, 12, 15, 19, 24, and 29-31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 4, 8, 9, and 24 are indefinite because the lighting conditions under which the pupil is to be measured is undefined thus the distance from the center to a point on the pupils periphery, e.g. in claim 9 cannot be pre determined. Claim 12 is indefinite as none of X, F(X), K₃, or factor are defined therein. In claim 15 exactly what constitutes "opposite radial sides of a vertical line" is unclear. In claim 19 exactly what is intended to be encompassed by "a lower quarter of the depth region" is unclear. Claim 30 is indefinite because the term "input data reception area means" has no function associated therewith.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

Revised section 102(e): For examining all Applications, whenever filed, and for reexamining of all Patents, and for determining the prior art dates¹ of patents and certain Application Publications:

A person shall be entitled to a patent unless-

(e) The invention was described in (1) an application for patent, published under section 122 (b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21 (2) of such treaty in the English language; or

Pre-AIPA section 374: For WIPO Publication of International Applications filed prior to November 29, 2000:

The publication under the treaty of an international application shall confer no rights and shall have no effect under this title other than that of a printed publication.

Revised section 374: For WIPO Publications of International Applications filed on or after November 29, 2000:

The publication under the treaty defined in section 351(a) of this title, of an international application designating the United States shall be deemed a publication under section 122 (b), except as provided in sections 102(e) and 154(d) of this title.

Effective Date Provisions for the amendments to sections 102(e) and 374, as amended by H.R. 2215:

Except as otherwise provided in this section, sections 4502 through 4504 and 4506 through 4507, and the amendments made by such sections, shall be effective as of November 29, 2000, and shall apply only to applications (including international applications designating the United States) filed on or after that date. The amendments made by section 4504 shall additionally apply to any pending application filed before November 29, 2000, if such pending application is published pursuant to a request of the applicant under such procedures as may be established by the Director.

Claim 10 is rejected under 35 U.S.C. 102(e) as being clearly anticipated by Largent.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 10, 13, and 16-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Largent in combination with Dunn. Largent teaches an optical surface including multiple concentric annular zones of various curvatures. Dunn teaches the various zone radii claimed

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when producing an optical surface to mitigate presbyopia. It would have been obvious to the artisan of ordinary skill to employ the zone boundaries of Dunn in the method of Largent, since there are appropriate for treating presbyopia; and to produce the aspheric curvature with the claimed angular relations, since these are not critical and Largent gives no caution to avoid these values, thus producing method such as claimed.

Claims 5-7 and 25-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Largent in combination with Shimmick. Largent teaches a laser system for correcting presbyopia. Shimmick teaches modifying a laser system. It would have been obvious to relate the tissue removal of Largent to the nasal superior point, since this would amount to a mere shifting of the co-ordinate system the computer uses when producing an optical correction centered on the optical axis and would provide no unexpected result, and to mark the zone which is the reference point, since this would facilitate tracking thereof official notice of which is hereby taken, and to employ the modification in the flying spot of Shimmick, since Largent provides no particular laser system, or to use an erodable mask, since this is a notorious equivalent to the flying spot system, official notice of which is hereby taken thus producing a device such as claimed.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-31 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-56 of U.S. Patent No. 6,302,877. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are merely an obvious variation in scope.

Any inquiry concerning this communication should be directed to David Shay at telephone number 308-2215.

Shay/dl

April 9, 2003



DAVID M. SHAY
PRIMARY EXAMINER
GROUP 330